



1646

PATENT
ATTORNEY DOCKET NO.: REGEN1260-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Tsien et al. Art Unit: 1646
Application No.: 10/057,505 Examiner: Unassigned
Filed: January 25, 2002
Title: TANDEM FLUORESCENT PROTEIN CONSTRUCTS

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Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL SHEET

Transmitted herewith for the above-identified application please find:

1. Information Disclosure Statement (2 pages);
2. Form PTO-1449 (8 pages);
3. Form PTO-892 (1 page);
4. A copy of the International Search Report dated April 27, 1998 (8 pages);
5. Return Receipt Postcard.

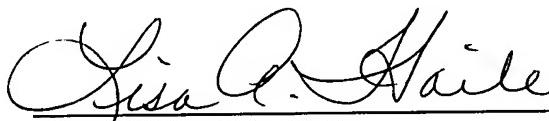
CERTIFICATION UNDER 37 CFR §1.8	
I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, January 30, 2003, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.	
Carrie E. Bickle (Name of Person Mailing Paper) <i>Carrie E. Bickle</i> (Signature)	January 30, 2003 (Date)

In re Application of
Tsien et al.
Filed: January 25, 2002
Page 2

PATENT
Attorney Docket No. REGEN1260-3

No fee is deemed necessary in connection with the filing of this Information Disclosure Statement, because it is being filed prior to the receipt of a first office action on the merits of the above-captioned application. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1355. A duplicate copy of this Transmittal sheet is enclosed.

Respectfully submitted,



Date: January 30, 2003

Lisa A. Haile, J.D., Ph.D.
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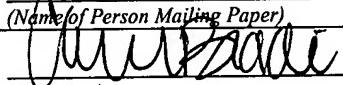
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INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with 37 C.F.R. § 1.97, Applicants bring to the Examiner's attention the related parent patent application, U.S. Serial No. 09/396,003 filed September 13, 1999, which is relied upon for an earlier filing date under 35 U.S.C. § 120.

Applicants respectfully request that the references supplied in compliance with 37 C.F.R. § 1.97 in the above-referenced parent application, as well as those cited during its examination, be made of record. For the convenience of the Examiner, enclosed are copies of Form PTO-1449, Form PTO-892 and a copy of the International Search Report listing the references

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Page 2

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Attorney Docket No. REGEN1260-3

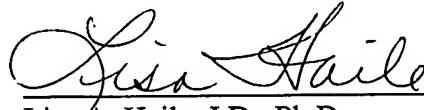
cited by the Examiner or cited in an Information Disclosure Statement or from a communication from a foreign patent office. Copies of the documents will be found in the above-referenced parent application.

It is respectfully requested that the parent application and the references cited therein be considered in the examination of this application and that their consideration be made of written record in the application file.

No fee is deemed necessary in connection with the filing of this Information Disclosure Statement, because it is being filed prior to the receipt of a first office action on the merits of the above-captioned application. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1355. A duplicate copy of this Transmittal sheet is enclosed.

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O P E R A T I O N S
INFORMATION DISCLOSURE STATEMENT
(Use several sheets if necessary)FEB 07 2003
PATENT & TRADEMARK OFFICE
SC165

APPLICANT: Tsien et al.

FILING DATE:
September 13, 1999GROUP:
1655

U.S. PATENT DOCUMENTS							
*EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME		CLASS	SUBCLASS	FILING DATE
	5,614,191	03/25/97	Puri et al.				RECEIVED

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*EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO
F1	WO 91/01305	02/07/91	PCT				
F2	WO 95/07463	03/16/95	PCT				
F3	WO 95/21191	08/10/95	PCT				
F4	WO 97/11094	03/27/97	PCT				
F5	WO 97/28261	08/07/97	PCT				

OTHER PUBLICATIONS (including Author, Title, Date, Pertinent Pages, Etc.)

D1	Ward et al., An Energy transfer protein in coelenterate bioluminescence. Characterization of the Renilla green fluorescent protein. J. Biol. Chem. 254 no 3 (1979) 781-788
D2	Geoghegan et al., Site directed double fluorescent tagging of human renin and collagenase (MMP-1) substrate peptides using the periodate oxidation of N-terminal serine. An apparently general strategy for provision of energy transfer substrates for proteases. Bioconjugate Chemistry 4 no 6, (1993) 537-544
D3	Wu et al. Resonance energy transfer: Methods and applications. Analytical Biochemistry 218, 1194, p1-13 Academic press Inc., Duluth, NM
D4	Inouye and Tsuji, Expression of the gene and fluorescence characteristics of the recombinant proteins. FEBS Letters 341:277-280 (1994)
D5	Mitra et al., Fluorescence resonance energy transfer between blue emitting and red-shifted excitation derivatives of the green fluorescent protein. Gene, 173:13-17 (1996)

EXAMINER

DATE CONSIDERED

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609: Draw line through citation if not in conformation and not considered. Include a copy of this form with the next communication to applicant.

SUBSTITUTE FORM PTO-1449 (MODIFIED)	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. 07257/041001	SERIAL NO. 08/792,553
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <small>(Use several sheets if necessary)</small>		APPLICANT: Tsien <i>et al.</i>	
<i>O P F</i> <i>0 7 2003</i>		FILING DATE January 31, 1997	GROUP 1801
(37 CFR 1.98(b))			

U.S. PATENT DOCUMENTS

FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

OTHER DOCUMENTS (including Author, Title, Date, Place of Publication)

DATE CONSIDERED

EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

O P E INFORMATION DISCLOSURE STATEMENT
(Use several sheets if necessary)

FEB 07 2003

APPLICANT: Tsien et al.

FILING DATE:
January 31, 1997GROUP:
1815

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE
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FOREIGN PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	FI							

OTHER PUBLICATIONS (including Author, Title, Date, Pertinent Pages, Etc.)

	D1	Guiliano et al., Fluorescent Protein Biosensors: Measurement of Molecular Dynamics in Living Cells, Annual Review of Biophysics and Biomolecular Structure, 24:405 (1995).
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PATENT & TRADEMARK OFFICE
APPLICANT: Tsiel et al.FILING DATE:
January 31, 1997GROUP:
1815

U.S. PATENT DOCUMENTS

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FOREIGN PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	FI							

OTHER PUBLICATIONS (including Author, Title, Date, Pertinent Pages, Etc.)

	DI	Roth. Thesis from the Graduate Program in Biochemistry from Rutgers, the State University of New Jersey (October 1985)
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)		APPLICANT: Roger Y. Tsien et al.		
		FILING DATE 01/31/97	GROUP 1815	
(37 CFR 1.98(b))				

OCT 12 1998
FEB 07 2003

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		PATENT NUMBER	ISSUE DATE	PATENTEE	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
		TRADENAME					
	AA	5 4 9 1 0 8 4	02/13/96	Chalfie			
	AB	5 2 6 4 5 6 3	11/23/93	Huse			
	AC	5 6 2 5 0 4 8	04/29/97	Tsien et al.			
	AD	4 3 1 4 9 3 6	02/09/82	Yaron et al.			
	AE	5 6 0 2 0 2 1	02/11/97	Davis et al.			
	AF	5 5 9 9 9 0 6	02/04/97	Dasmahapatra			
	AG	5 6 0 5 8 0 9	02/25/97	Komoriya et al.			

FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

		DOCUMENT NUMBER	PUBLICATION DATE	COUNTRY OR PATENT OFFICE	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	AH	WO 94/28173	12/08/94	PCT				
	AI	WO 96/13607	05/09/96	PCT				
	AJ	WO 94/28166	12/08/94	PCT				
	AK	WO 96/23810	08/08/96	PCT				
	AL	WO 96/23898	08/08/96	PCT				
	AM	WO 96/27675	09/12/96	PCT				
	AN	WO 96/27027	09/06/96	PCT				
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AP	Cody et al., "Chemical Structure of the Hexapeptide Chromophore of the Aequorea Green-Fluorescent Protein", <u>Biochemistry</u> , 1993, 32, pp. 1212-1218
AQ	Ward et al., "Reversible Denaturation of Aequorea Green-Fluorescent Protein: Physical Separation and Characterization of the Renatured Protein," <u>Biochemistry</u> , 1982, 21, pp. 4535-4540
AR	Surpin et al., "Reversible Denaturation of Aequorea Green Fluorescent Protein-Thiol Requirement," <u>Photochem. Photobiol.</u> , 49, Abstract, 25S (1989)
AS	Muhlrad et al., "A Rapid Method for Localized Mutagenesis of Yeast Genes," <u>Yeast</u> , 8, pp. 79-82 (1992)
AT	Ward, "Properties of the Coelenterate Green-Fluorescent Proteins", <u>Bioluminescence and Chemiluminescence</u> , (eds. DeLuca, M.A. & McElroy, W.D.) 235-242 (Academic Press, New York 1981)

EXAMINER	DATE CONSIDERED
EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

SUBSTITUTE FORM PTO-1449 (MOTORIZED) O I P E S C O R E FEB 07 2003 PATENT & TRADEMARK (37 CFR 1.98(b))		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO. 07257/041001	SERIAL NO. 08/792,553
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)				APPLICANT: Tsien et al.	RECEIVED
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U.S. PATENT DOCUMENTS

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EXAMINER INITIAL		PATENT NUMBER	ISSUE DATE	PATENTEE	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
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FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

		DOCUMENT NUMBER	PUBLICATION DATE	COUNTRY OR PATENT OFFICE	CLASS	SUBCLASS	TRANSLATION YES NO
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AU	Ehrig et al., "Green-fluorescent protein mutants with altered fluorescence excitation spectra", (1995) <u>FEBS Letters</u> , 367(2) pp. 163-166
AV	Delagrange et al., "Red-Shifted Excitation Mutants of the Green Fluorescent Protein", <u>BioTechnology</u> , 13:151-154 (1995)
AW	Kain et al., "Green Fluorescent Protein as a Reporter of Gene Expression and Protein Localization," <u>BiTechniques</u> , 19(4): pp. 650-655 (1995)
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AY	Kemp et al., "Protein kinase recognition sequence motifs," <u>Trends Biochem. Sci.</u> , 15:342-346 (1990)
AZ	Songyang et al., "Use of an oriented peptide library to determine the optimal substrates of protein kinases", <u>Current Biology</u> , 4:973-982 (1994)
BA	Colbran et al., "A Phenylalanine in Peptide Substrates Provides for Selectivity between cGMP- and cAMP-dependent Protein Kinases," <u>J. Biol. Chem.</u> , 267:9589-9594 (1992)
BB	Graff et al., "Protein Kinase C Substrate and Inhibitor Characteristics of Peptides Derived from the Myristoylated Alanine-rich C Kinase Substrate (MARCKS) Protein Phosphorylation Site Domain", <u>J. Biol. Chem.</u> , 266:14390-14398 (1991)
BC	Lee et al., "A requirement of hydrophobic and basic amino acid residues for substrate recognition by Ca ²⁺ /calmodulin-dependent protein kinase Ia," <u>Proc. Natl. Acad. Sci. USA</u> , 91:6413-6417 (1994)
BD	Stokoe et al., "The Substrate Specificity and Structure of Mitogen-Activated Protein (MAP) Kinase-Activated Protein Kinase-2", <u>Biochem. J.</u> , 296:843-849 (1993)
BE	Cheng et al., "Use of green fluorescent protein variants to monitor gene transfer and expression in mammalian cells," <u>Nature Biotechnology</u> , 14:606-609 (1996)
BF	Heim et al., "Engineering green fluorescent protein for improved brightness, longer wavelengths and fluorescence resonance energy transfer," <u>Current Biology</u> , 6(2):178-182 (1996)
BG	Yaron et al., "Intramolecularly Quenched Fluorogenic Substrates for Hydrolytic Enzymes," <u>Analytical Biochemistry</u> , 95, 228-235 1979
BH	L. Stryer, "Fluorescence Energy Transfer As A Spectroscopic Ruler," <u>Ann. Rev. Biochem.</u> , 1978, 47:819-46
BI	Ward et al., "Spectral Perturbations of the Aequorea Green-Fluorescent Protein, <u>Photochem. Photobiol.</u> , 1982, 35:803-808

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DATE CONSIDERED

EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

SUBSTITUTE FORM PTO-1449 (MOTORIZED) O P T E FEB 07 2003 PATENT & TRADEMARK (37 CFR 1.58(b))		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO. 07257/041001	SERIAL NO. 08/792,553
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)		APPLICANT: Tsien et al.		RECEIVED FEB 10 2003	
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EXAMINER INITIAL		PATENT NUMBER	ISSUE DATE	PATENTEE	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
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		DOCUMENT NUMBER	PUBLICATION DATE	COUNTRY OR PATENT OFFICE	CLASS	SUBCLASS	TRANSLATION
							YES NO

OTHER DOCUMENTS (including Author, Title, Date, Place of Publication) Continued

BJ	Levine et al., "Isolation and Characterization of a Photoprotein, "Phialidin", and a Spectrally Unique Green-Fluorescent Protein from the Bioluminescent Jellyfish <i>Phialidium Gregarium</i> ", <u>Comp. Biochem. Physiol.</u> , 1982, 72B:77-85
BK	Matayoshi et al., "Novel Fluorogenic Substrates for Assaying Retroviral Proteases by Resonance Energy Transfer", <u>Science</u> , 1990, 247:954
BL	Baldwin et al., "Cloning and Expression of the luxY Gene from <i>Vibrio fischeri</i> Strain Y-1 in <i>Escherichia coli</i> and Complete Amino Acid Sequence of the Yellow Fluorescent Protein," <u>Biochemistry</u> , 1990, 29:5509-15
BM	Blondel et al., "Engineering the quaternary structure of an exported protein with a leucine zipper," <u>Protein Engineering</u> , 1991, 4:457-461
BN	Prasher et al., "Primary Structure of the <i>Aequorea victoria</i> green-fluorescent protein," <u>Gene</u> , 1992, 111:229-233
BO	Tsien et al., "FRET for studying intracellular signalling," <u>Trends Cell Biol</u> , 1993, 3:242-245
BP	Wilbanks et al., "Rod Structure of a Phycoerythrin II-containing Phycobilisome," <u>J. Biol. Chem.</u> , 1993, 268:1226-35
BQ	Dunn et al., "Subsite Preference of Retroviral Proteinase," <u>Meth. Enzymol.</u> , 1994, 241:254
BR	Hardy et al., "Amyloid Protein Precursor in Development, Aging, and Alzheimer's Disease," <u>ed., C.L. Masters et al.</u> , pp. 190-198
BS	Norris et al., "Nucleotide sequence of a cDNA clone encoding the precursor of the peridinin-chlorophyll a-binding protein from the dinoflagellate <i>symbiodinium</i> sp." <u>Plant Molecular Biology</u> , 1994, 24:673-77
BT	Krafft et al., "Synthetic approaches to continuous assays of retroviral proteases," <u>Methods Enzymol.</u> , 1994, 241:70-86
BU	Heim et al., "Wavelength mutations and posttranslational autoxidation of green fluorescent protein," <u>Proc Natl Acad Sci, USA</u> , 1994, 91:12501-12504
BV	Chalfie et al., "Green Fluorescent Protein as a Marker for Gene Expression," <u>Science</u> , 1994, 263:802-805
BW	Seidah et al., "Pro-Protein Convertases of Subtilisin/Kexin Family," <u>Meth. Enzymol.</u> , 1994, 244:175
BX	Smith et al., "Purification and Kinetic Characterization of Human Cytomegalovirus Assemblin," <u>Meth. Enzymol.</u> , 1994, 244:412
BY	Thornberry, "Interleukin-1 β Converting Enzyme," <u>Meth. Enzymol.</u> , 1994, 244:615
BZ	Bouvier et al., "Leishmanolysin: Surface Metalloproteinase of Leishmania," <u>Meth. Enzymol.</u> , 1995, 248:614

EXAMINER	DATE CONSIDERED
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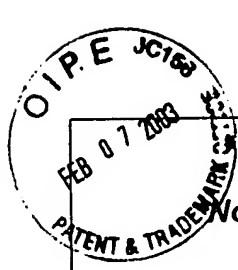
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SUBSTITUTE FORM PTO-1449 (MOTIE) FEB 07 2003 PATENT & TRADEMARK (37 CFR 1.98(b))		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO. 07257/041001		SERIAL NO. 08/792,553			
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)				APPLICANT: Tsien et al.					
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								YES	NO
OTHER DOCUMENTS (including Author, Title, Date, Place of Publication)									
CA	Cubitt et al., "Understanding, improving and using green fluorescent proteins," <u>Trends Biochem Sci</u> , 1995, in press:								
CB	Deschamps et al., "Rapid Purification of Recombinant Green Fluorescent Protein Using the Hydrophobic Properties of an HPLC Size-Exclusion Column," <u>Protein Expression and Purification</u> , 1995, 6:555-558								
CC	Heim et al., "Improved green fluorescence," <u>Nature</u> , 1995, 373:663-664								
CD	Knight, "Fluorimetric assays of proteolytic enzymes," <u>Methods Enzymol</u> , 1995, 248:18-34								
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Substitute Disclosure Form (PTO-1449)

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Notice of References Cited

Application/Control No.

09/396,003

Applicant(s)/Patent Under

Reexamination

TSIEN ET AL.

Examiner

Bradley L. Sisson

Art Unit

1655

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
*	A	US-5981200-	11-1999	Tsien et al.	435	7.4
	B	US- -				
	C	US- -				
	D	US- -				
	E	US- -				
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FOREIGN PATENT DOCUMENTS

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	N	- -				RECEIVED
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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.